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In re Application of FUHRMANN et al	:	DECISION ON PETITION
U.S. Application No.: 09/214,158	:	
Int. Application No.: PCT/US97/03984	:	UNDER 37 C.F.R. § 1.181,
Int. Filing Date: 12 March 1997	:	
Priority Date: 14 March 1996	:	37 C.F.R. § 1.137(b), AND
Attorney Docket No.: TER-004.2P	:	
For: DATA TRANSMISSION USING ATM	:	37 C.F.R. § 1.47(a)
OVER HYBRID FIBER COAX	:	

This is in response to applicants' "Petition to Withdraw Holding of Abandonment Under 37 CFR 1.181(a) (or Under 37 CFR 1.137(b) in the Alternative) and to Accept the Application Without the Signature of Inventor Fuhrmann Under 37 CFR 1.47(a)" filed 01 May 2000, requesting that the holding of abandonment be withdrawn. Applicant alternatively requests, in the event such petition is not granted, that the application be revived on the grounds of unintentional abandonment. Applicant further requests that the present United States national stage application be accepted without the signature of inventor Amir Fuhrmann.

BACKGROUND

On 12 March 1997, applicants filed international application PCT/US97/03984, which claimed priority of an earlier United States application filed 14 March 1996. A Demand for international preliminary examination, in which the United States was elected, was filed on 12 November 1997, **after** the expiration of nineteen months from the priority date. On 12 November 1997 applicants filed a request with the United States Receiving Office (RO/US) to withdraw the earliest priority claim (14 March 1996), thus making the earliest remaining priority date 19 July 1996. Accordingly, the twenty-month period for paying the basic national fee in the United States expired at midnight on 19 March 1998.

On 19 March 1998, the application became abandoned as to the United States of America for failure to pay the basic national fee within twenty months from the priority date.

On 23 December 1998, applicants filed national stage papers in the United States of America, including the requisite basic national fee, the appropriate surcharge under 37 CFR 1.492(e), and a declaration signed by two of the three inventors. The declaration is not signed by inventor Amir Fuhrmann.

On 03 August 1999, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 12 August 1999, applicants filed a "Petition Under 37 CFR 1.47" requesting that the present U.S. national stage application be accepted without the signature of Fuhrmann.

On 08 March 2000, the PCT Legal Office mailed a decision dismissing the 12 August 1999 petition on grounds that applicants had not demonstrated that a bona fide attempt was made to present a copy of the application papers to Fuhrmann for signature.

On 01 May 2000, applicants filed the present petition. The petition states that it is accompanied by the declaration of attorney Ronald Craig Fish which purportedly demonstrates that a bona fide attempt was made to present a copy of the application papers to Fuhrmann for signature.

DISCUSSION

I. Petition under 37 CFR 1.181 to withdraw holding of abandonment.

PCT Rule 90*bis*.3(a) states, "The applicant may withdraw a priority claim, made in the international application under Article 8(1), at any time prior to the expiration of 20 months from the priority date or, where Article 39(1) applies, 30 months from the priority date."

PCT Rule 90*bis*.3(d) states, "Where the withdrawal of a priority claim causes a change in the priority date, any time limit which is computed from the original priority date and which has not already expired shall, subject to paragraph (e), be computed from the priority date resulting from that change."

In the present case, applicants requested to withdraw the 14 March 1996 priority claim on 12 November 1997, prior to the 20 month deadline set forth in Rule 90*bis*.3(a). Rule 90*bis*.3(d) clearly indicates that because the 19 month time limit to file the Demand had already expired, any change in the priority date would have no effect on the time limit in which to file the Demand.

The petition argues that Rule 90*bis*.3 is unfair to applicants who withdraw a priority claim between 19 and 20 months from the priority date, in that such a withdrawal does not allow applicants to extend the date by which the national stage must be entered. This is incorrect

because under Rule 90*bis*.3, the deadline to enter the national stage for applicants who withdraw a priority claim between 19 and 20 months from the priority date is extended to 20 months from the new priority date. Thus, applicants' 12 November 1997 request to withdraw the 14 March 1996 priority claim extended the deadline to enter the national stage to 19 March 1998, which is 20 months from 19 July 1996, the earliest remaining priority date.

Pursuant to Rule 90*bis*.3(d), because the 19 month deadline for filing the Demand had already expired prior to the withdrawal of a priority claim, the deadline for entering the national stage expired on 19 March 1998. Because the basic national fee was not timely filed, the application became abandoned as to the United States of America on 19 March 1998.

II. Petition under 37 CFR 1.137(b) to revive unintentionally abandoned application.

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), applicants have provided the requisite basic national fee.

With regard to item (2), applicants have authorized the USPTO to charge the requisite petition fee.

With regard to item (3), the petition includes a statement that the entire delay in filing the required reply from the due date for the reply until the filing of the present petition was unintentional.

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

III. Petition under 37 CFR 1.47(a) to accept the application without signature of an inventor.

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, the declaration filed 23 December 1998 is improper because it is not signed by both Selim Rakib and Yehuda Azenkot. It is not sufficient to submit

only the signature page of the declaration. Applicants must file either 1) a single complete declaration signed by both Rakib and Azenkot or 2) multiple complete declarations, with each inventor's signature appearing on one of the multiple complete declarations. Furthermore, the declaration filed 23 December 1998 does not appear to be properly executed. Specifically, pages 1 and 2 of the declaration appear to be original sheets, but page 3 of the declaration appears to have been transmitted by facsimile. This suggests that the first two pages of the declaration filed 23 December 1998 were not associated with the signature page at the time of execution, thus rendering the execution improper. Applicant must provide a complete declaration which is presented to and signed by the executors.

With regard to item (2) above, MPEP 409.03(d) states in part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

In the present case, the declaration of attorney Ronald Craig Fish establishes with reasonable certainty that a bona fide attempt was made to present a copy of the application papers to Fuhrmann for signature. Specifically, the declaration of Fish states that on 10 April 2000 a copy of the application papers (including the specification, claims, drawings, and declaration) was sent to Fuhrmann at his last known address by registered mail. This statement is corroborated by a copy of a cover letter addressed to Fuhrmann and signed by Fish (Exhibit T) and a copy of a registered mail receipt dated 10 April 2000 (Exhibit T).

Furthermore, the declaration of Fish establishes with reasonable certainty that Fuhrmann refuses to sign the application papers. Specifically, Fuhrmann's refusal to sign is evidenced by a copy of the front of a returned letter (Exhibit U) which bears a registered mail number matching that shown on the registered mail receipt (Exhibit T). The returned letter is marked "Returned to Sender" due to refusal by the addressee to accept delivery.

With regard to item (3) above, applicants have provided the requisite petition fee.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor Fuhrmann.

CONCLUSION

For the reasons set forth in §I above, the petition under 37 CFR 1.181 to withdraw the holding of abandonment is **DISMISSED** without prejudice.

For the reasons set forth in §II above, the petition under 37 CFR 1.137(b) to revive the present unintentionally abandoned application is **GRANTED**.

For the reasons set forth in §III above, the petition under 37 CFR 1.47(a) to accept the present application without the signature of one of the inventors is **DISMISSED** without prejudice.

The petition fee of \$605.00 as set forth in 37 CFR 1.17(m) will be charged to Deposit Account No. 06-0932 per applicants' authorization.

If reconsideration on the merits of this decision is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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